



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/056,584	01/24/2002	Gerhard Pfeifer	5005.1018	4703

23280 7590 09/08/2003

DAVIDSON, DAVIDSON & KAPPEL, LLC
485 SEVENTH AVENUE, 14TH FLOOR
NEW YORK, NY 10018

EXAMINER

PRITCHETT, JOSHUA L

ART UNIT	PAPER NUMBER
----------	--------------

2872

DATE MAILED: 09/08/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/056,584

Applicant(s)

PFEIFER, GERHARD

Examiner

Joshua L Pritchett

Art Unit

2872

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 July 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 January 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other:

DETAILED ACTION

This action is in response to Amendment A filed July 21, 2003. Claims 1, 4 and 6-7 have been amended as requested by the applicant.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-5 are rejected under 35 U.S.C. 101 because the disclosed invention is inoperative and therefore lacks utility.

Claim 1 states that the "abutment surface contacting the specimen slide in a region below an upper edge of the specimen slide." Claim 1 also states the, "abutment surface of the opening is configured in such a way that it exerts, on the specimen slide that is pressed against the abutment surface, a force component directed substantially downward onto the support surface." Based on the claim language and Fig. 4 of the current application there appears to be no physical reason the specimen slide would experience the claimed downward force illustrated with arrow F_A . Based on Newton's Laws the specimen slide should experience a force exerted back on it from the abutment surface in an equal and opposite direction as the force applied to it by the spring (illustrated as arrow F). The contact surface of the abutment surface is flat and therefore

Art Unit: 2872

would not cause the force of the spring to be broken into vector components. Therefore claim 1 as claimed is inoperative. Claims 2-5 depend from claim 1 and are therefore also inoperative.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Georges in view of Admitted Prior Art.

Georges discloses an X-Y microscope stage defining a stage surface (Fig. 6). Georges further discloses a holder, arranged above the stage surface of the X-Y microscope stage and being positionable in X and Y directions (col. 12 lines 33-34), for positioning the specimen slide. Georges further discloses an opening for the specimen slide is formed in a baseplate (35) of the holder, wherein the opening is configured with support surfaces (21 and 21') and abutment surfaces (27) for the specimen slide. Georges further discloses a spring element (48) is mounted on the specimen slide for pressing the specimen slide against the abutment surface of the opening so that the specimen on the specimen slide is located opposite the stage surface (Fig. 6). Georges lacks specific reference to a specimen collection device, however Georges teaches that such a

Art Unit: 2872

device is known and used in the art. Georges further lacks reference to the slide extending above the upper edge of the abutment surface. Georges further teaches a collection device having at least one container for collecting a specimen that has be cut out, wherein the collection device being conveyable to an opening working space configured between the holder and the stage surface (col. 1 lines 17-21). Admitted Prior Art teaches that it is known in the art to have the slide extend above the upper edge of the abutment surface (Fig. 3 current application). It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have the Georges invention include a specimen collection device for the purpose of preserving the specimen for further analysis at a later date. It would further have been obvious to a person of ordinary skill in the art at the time the invention was made to have the Georges slide extend above the upper edge of the abutment surface as taught by the Admitted Prior Art for the purpose of allowing the viewing apparatus of the microscope to get as close as possible to the specimen slide without interference from the abutment surface.

Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Georges in view of Hellmuth and Admitted Prior Art.

Georges discloses the invention as claimed and discussed in the rejection of claim 6, but lacks reference to the use of an apparatus for laser cutting the specimen. Georges further lacks reference to the slide extending above the upper edge of the abutment surface. Hellmuth teaches the use of an apparatus for laser cutting the specimen in a microscope (col. 11 lines 67 – col. 12 line 2). Admitted Prior Art teaches that it is known in the art to have the slide extend above the upper edge of the abutment surface (Fig. 3 current application). It would have been obvious to a

Art Unit: 2872

person of ordinary skill in the art at the time the invention was made to have the Georges invention include the laser cutting apparatus as taught by Hellmuth for the purpose of removing pieces of the specimen to examine a cross section of the specimen or reduce the size of the specimen. It would further have been obvious to a person of ordinary skill in the art at the time the invention was made to have the Georges slide extend above the upper edge of the abutment surface as taught by the Admitted Prior Art for the purpose of allowing the viewing apparatus of the microscope to get as close as possible to the specimen slide without interference from the abutment surface.

Response to Arguments

Applicant's arguments, see Amendment A, filed July 21, 2003, with respect to objections to claims 1-5 have been fully considered and are persuasive. The objection of claims 1-5 has been withdrawn.

Applicant's arguments filed July 21, 2003 have been fully considered but they are not persuasive.

The applicants arguments on pages 6-8 of Amendment A argue that the newly added subject matter, "the at least one abutment surface contacting the specimen slide in a region below an upper edge of the specimen slide." The applicant argues that this newly added subject matter makes the current invention distinguishable over the prior art of record. The examiner does not

Art Unit: 2872

believe that the newly added subject matter is physically possible. The independent claims 1, 6 and 7 state the limitation that the slide is pressed against the abutment surface in such a way that “a force component is directed substantially downward onto the support surface of the opening.” Fig. 4 shows the claimed downward force, however the examiner does not understand how the force acts downward to hold the slide in place. With no surface above the upper edge of the slide there appears to be no surface to create a reactive downward force vector in response to the force of the spring that would hold the slide in place against the support surface. Fig. 4 shows a single horizontal force (F) that is broken into vector forces (F_s and F_a), however the slide only contacts a single surface of the abutment surface and that surface is flat. Therefore there appears to be no reason why the single horizontal force (F) would break into components (F_s and F_a). The flat surface of the abutment surface as shown in Fig. 4 show exert an equal and opposite force to that of the spring force (F). The only downward force that should be present in the current invention is the force of gravity, which is inherent and would also hold the slide of Georges down. The newly added subject matter is not given significant patentable weight because it does not appear to the examiner to be physically possible.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

Art Unit: 2872


A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joshua L Pritchett whose telephone number is 703-305-7917. The examiner can normally be reached on Monday - Friday 7:00 - 3:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Drew Dunn can be reached on 703-305-0024. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0956.

JLP


DREW DUNN
SUPERVISORY PATENT EXAMINER